

REMARKS

I. Status of Claims

Claims 1-19 and 21-131 are pending. Claims 43-131 have been withdrawn from consideration as being directed to non-elected subject matter.

In the present Amendment, claims 1 and 42 have been amended by adding the limitation recited in claim 11. Claim 11 has been canceled. Applicants have not introduced any new matter by the amendment, nor are any estoppels intended thereby.

Claims 1-10, 12-19, and 21-42 are under Examination.

II. Rejection under 35 U.S.C. § 102

The Examiner rejects claims 1-5, 7-11, 18, 19, 21, 25, 26, 29, 32-34, and 37-41 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,793,994 to Helioff et al. ("*Helioff*"). Office Action, page 2. Specifically, the Examiner alleges that *Helioff* teaches a hair treating composition "comprising ammonium hydroxide, a reducing agent of sodium bisulfite and a complexing agent of chelating agent as claimed in claims 1, 2, [and] 40" (citing col. 5, lines 15-31). *Id.* Accordingly, the Examiner concludes that *Helioff* anticipates the rejected claims. *Id.* at page 3. Applicants respectfully disagree with the Examiner and traverse this rejection for the reasons of record and the following additional reason.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). Further, a rejection under § 102 is proper only when the claimed subject matter is identically described or

disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (CCPA 1972) (emphasis added).

Here, *Helioff* does not teach each and every limitation of the rejected claims. Specifically, *Helioff* does not teach the composition comprising at least one hydroxide compound, at least one reducing agent, and at least one complexing agent, wherein the at least one reducing agent is “present in an amount ranging from 0.1% to 5% by weight relative to the total weight of the composition” as recited in, for example, claim 1 as currently amended.

For example, in the “Single Step Waving Formulation” disclosed in column 5, lines 9-14, *Helioff* teaches ammonium thioglycolate in an amount of 0.2% by weight relative to the total weight of the composition. However, that formulation does not contain, at least, a hydroxide compound.

Further, the reducing agent of ammonium bisulfite in the “Bisulfite Waving Formulation” disclosed in column 5, lines 15-24 of *Helioff* is present in an amount of 22% by weight relative to the total weight of the composition, falling outside of the scope of the presently claimed invention.

Accordingly, this rejection is improper. Applicants respectfully request this rejection be withdrawn.

III. Rejections under 35 U.S.C. § 103

A. *Helioff*

The Examiner rejects claims 6, 22, 23, 36, and 42 under U.S.C. § 103(a) as being unpatentable over *Helioff*. Office Action, pages 3-5. Applicants respectfully

disagree and traverse this rejection for the reasons of record and the following additional reason.

To establish a *prima facie* case of obviousness, three basic criteria must be met, including that the prior art reference must teach or suggest all the claim limitations and that there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. M.P.E.P. § 2143. The evidence of a suggestion or motivation to modify or combine “must be found in the prior art reference, not in the applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The Examiner has failed to show that *Helioff* teaches or suggests the composition comprising at least one hydroxide compound, at least one reducing agent, and at least one complexing agent, wherein the at least one reducing agent is “present in an amount ranging from 0.1% to 5% by weight relative to the total weight of the composition” as recited in, for example, claim 1 as currently amended.

Further, the Examiner has failed to point to any evidence of a suggestion or motivation to modify *Helioff* to arrive at the presently claimed invention. Indeed, *Helioff*’s disclosure of the reducing agent of ammonium bisulfite in the “Bisulfite Waving Formulation” in column 5, lines 15-24 being present in an amount of 22% by weight relative to the total weight of the composition, in combination with ammonium hydroxide and the chelating agent, teaches away from the presently claimed invention. Therefore, this rejection is improper.

Accordingly, as the Examiner has not established a *prima facie* case of obviousness, Applicants respectfully request that this rejection be withdrawn.

B. *Helioff* in view of *Au*, *Mathews*, or *Pyles*

The Examiner also rejects claims 12-17, 27, 30, and 31 under 35 U.S.C. § 103(a) as being unpatentable over *Helioff* in view of U.S. Patent No. 5,872,111 to Au et al. ("*Au*"), claims 24 and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Helioff* in view of U.S. Patent No. 4,816,246 to Mathews et al. ("*Mathews*"), and claim 28 under 35 U.S.C. § 103(a) as being unpatentable over *Helioff* in view of U.S. Publication No. US2001/0008630 A1 to Pyles et al. ("*Pyles*"). Office Action, pages 5-7. Applicants respectfully disagree with the Examiner and traverse these rejections for the reasons of record and the following additional reasons.

As discussed above, the Examiner has failed to show that *Helioff* teaches or suggests the composition comprising at least one hydroxide compound, at least one reducing agent, and at least one complexing agent, wherein the at least one reducing agent is "present in an amount ranging from 0.1% to 5% by weight relative to the total weight of the composition" as recited in, for example, claim 1 as currently amended.

Neither of the secondary references remedies this deficiency. Specifically, the Examiner merely relies on *Au* for its teaching of specific cation exchange components and complexing agents (Office Action, page 5), on *Mathews* for its teaching of specific chelating agents (Office Action, page 6), and on *Pyles* for its teaching of specific amino acid salt, i.e., monosodium glutamate (Office Action, page 7). Therefore, *Helioff* and the secondary reference, i.e., *Au*, *Mathews*, or *Pyles*, either alone or in combination, fail to teach or suggest all the limitations of the rejected claims.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request that these rejections be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned Applicants' representative at (202) 408-4218.

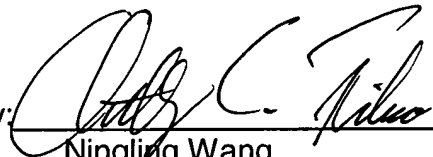
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 11, 2006

By:


Ningling Wang
Reg. No. 52,412

Filed Reg. No. 45,959 for